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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/492,969      | 01/27/2000  | Emily L. Brooks      |                     | 1609             |

7590 02/27/2004

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EXAMINER

HAN, MARK K

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3763

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/492,969

Applicant(s)

BROOKS ET AL.

Examiner

Mark K Han

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6 and 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

*Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 6 and 10-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,328,714 to Bellhouse et al. (hereinafter "Bellhouse '714") in view of U.S. Patent No. 5,630,796 to Bellhouse et al. (hereinafter "Bellhouse '796"). Claim 1 of Bellhouse '714 claims a replaceable cartridge for use in a needleless syringe but fails to claim a needleless syringe and a nozzle. Bellhouse '796 shows a needleless syringe having replaceable, particle acceleration nozzle 26 with a convergent upstream end 35 and a divergent downstream end 37 including a throat 36 connecting the convergent and divergent sections. See Figures 1-3 and col. 12, lines 44-64. The upper portion (with external threads) of the nozzle is wider than the rest of the nozzle, forming a projecting annular flange, which provides an external shoulder. See Figure 1 below. The cylindrical filter medium 39 surrounds the nozzle and rests upon the external shoulder. See col. 9, lines 9-25 and col. 13, lines 20-34. This nozzle is used with a replaceable gas cartridge 11 as disclosed in Figure 4 and col. 13, lines 49-67. It would have been obvious to one of ordinary skill in the art

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to include the needleless syringe (to provide a means of activating the cartridge) and a nozzle (to accelerate the particles), as suggested by Bellhouse '796, with the device as claimed in Claim 1 of Bellhouse '714.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 6 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Bellhouse '796.

Bellhouse '796 shows a needleless syringe having replaceable, particle acceleration nozzle 26 with a convergent upstream end 35 and a divergent downstream end 37 including a throat 36 connecting the convergent and divergent sections. See Figures 1-3 and col. 12, lines 44-64. The upper portion (with external threads) of the nozzle is wider than the rest of the nozzle, forming a projecting annular flange, which provides an external shoulder. See Figure 1 in Paper No. 16. The cylindrical filter medium 39 surrounds the nozzle and rests upon the external shoulder. See col. 9, lines 9-25 and col. 13, lines 20-34. This nozzle is used with a replaceable gas cartridge 11 as disclosed in Figure 4 and col. 13, lines 49-67.

### *Response to Arguments*

3. Applicant's arguments filed 23 January 2004 have been fully considered but they are not persuasive. In response to applicant's argument that the silencer part of Bellhouse '796 does not act as a particle filter, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The silencer part of Bellhouse '796 is a filter medium. The phrase, "filter medium", can be interpreted as a substance that would reject certain electric, electronic, acoustic, or optical signals, vibrations, or frequencies but would allow others through. The silencer of Bellhouse '796 fits within this mean as an acoustic filter medium that "acts to quiet the sonic boom of the injection" (p. 7, paragraph 5 of Applicants' January 23<sup>rd</sup> response) while letting some acoustic signals through the silencer. Additionally, the Applicants' filter medium can also act as a silencer by filtering sound of certain acoustic frequencies and letting others through. The structural limitations of the claims are therefore met, and the rejection under 35 U.S.C. 102(b) under Bellhouse '796 is hereby maintained.

### *Conclusion*

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark K Han whose telephone number is 703-308-4543. The examiner can normally be reached on Monday to Friday, 9 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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*mkh.*

Mark Han  
Patent Examiner  
Art Unit 3763

mkh

February 23, 2004

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